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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 28

Serial Number: 07/975,905
Filing Date: November 12, 1992
Appellant(s): Klug

10 MAY 1995

95-4544
James L. Johnson
For Appellant

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EXAMINER'S ANSWER

BOARD OF PATENT APPEALS
AND INTERFERENCES

This is in response to appellant's brief on appeal filed March 7, 1995.

(1) *Status of claims.*

The statement of the status of claims contained in the brief is correct.

(2) *Status of Amendments After Final.*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(3) *Summary of invention.*

The summary of invention contained in the brief is deficient because it is not simply a summary, or brief description, of the invention. Rather, it also includes arguments concerning the patentability of the claims over the prior art.

Art Unit: 2307

(4) *Issues.*

The appellant's statement of the issues in the brief is correct.

(5) *Grouping of claims.*

Appellant's brief does not include a statement that the claims do not stand or fall together. See 37 C.F.R. § 1.192(c)(5).

Appellant does state that:

claims 1, 3, and 5-8 stand or fall together;

claims 9, 10, 14, 15, and 17 stand or fall together;

claims 2, 4, 23, and 25-28 stand or fall together; and

claims 11 and 13 stand or fall together, and provides reasons why claims 1, 9, 23, and 11 are separately patentable.

(6) *Claims appealed.*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) *Prior Art of record.*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

U.S. Pat. No. 5,008,853 to Bly et al.

U.S. Pat. No. 5,173,854 to Kaufman et al.

Serial Number: 07/975,905

-3-

Art Unit: 2307

(8) *New prior art.*

A new reference has been applied in a new ground of rejection in this examiner's answer and listed below:

U.S. Pat. No. 5,300,943 to Jakobs et al.

(9) *Grounds of rejection.*

Appellant's arguments are persuasive. The rejection of claims 1-11, 13-15, 17-23, and 25-26 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,008,853 to Bly et al. ("Bly") in view of U.S. Patent No. 5,173,854 to Kaufman et al. ("Kaufman") is hereby withdrawn.

(10) *New ground of rejection.*

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Art Unit: 2307

Claims 1-11, 13-15, 17-23, and 25-26 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Pat. No. 5,300,943 to Jakobs et al. ("Jakobs").

With respect to claim 1, Jakobs taught the invention substantially as claimed including the computer file editing system for a plurality of users at different remote locations, comprising the:

- plurality of personal computers, one for each user (col.6, line 55), each including computer file display means (col.4, lines 9-11);
- interconnecting means for electrically interconnecting the host computer with the others of the plurality of personal computers to permit transmission of electrical signals corresponding with the file editing operations therebetween (col.9, lines 17-22);
- wherein the plurality of users are permitted to concurrently view the given computer file (col.6, lines 58-60) and, subject to practical system limitations, said computer, file display means, multi-tasking processing means, and interconnecting means operate so that said file editing operations and said corresponding limited data transfer to the display means occur on a substantially real-time basis relative to said edit inputs to permit the plurality of users at said different remote locations to view the edits made to the given computer file substantially contemporaneously with the corresponding input of said edits and execution of said file editing operations (col.6, lines 58-62).

Jakobs did not teach the use of personal computers as the workstations of their system, and while Jakobs's Background of the Invention may appear to actually teach away from implementing the system using personal computers, it only did so up to the time of their invention (October 3, 1986). By the time of the present invention (August

Art Unit: 2307

23, 1989), the capabilities of personal computers had long surpassed those of the personal computers of Jakobs's time, and one of ordinary skill in the art would have recognized that contrary teachings of Jakobs's Background of the Invention were no longer applicable.

Therefore, it would have been obvious to one of ordinary skill in the art to implement Jakobs's system using personal computers because of their popularity (col.1, lines 24-25), and because doing so would improve the system by permitting an embodiment which used common, and relatively low-cost components.

Jakobs did not specifically teach that at least one of the personal computers was to be designated the host computer for given file editing operations, and having multi-tasking processing means for coordinating the execution of said file editing comprising edits of less than the entire file inputted by at least one of the users, and for coordinating the transfer of data corresponding with, and limited to, the file editing operations from the host computer to the display means of the others of the plurality of personal computers whereby the file editing operations and corresponding limited data transfer are performed in a predetermined manner by the host computer.

Since Jakobs merely taught that their workstation was to be used in a distributed conferencing and editing system (col.6, lines 55-56), but did not discuss how the workstations were to be interconnected, it must be assumed that Jakobs intended the artisan to rely on what was known in the prior art at the time the art to implement the workstation of Jakobs in a distributed conferencing and editing system.

At the time of the present invention, distributed networks were commonly implemented using a personal computer based on the Intel 80386 microprocessor running

Art Unit: 2307

network software (e.g. Novell NetWare 386 version 3.0), i.e., a multi-tasking personal computer acting as the host). It would have been obvious to one of ordinary skill in the art at the time of the invention to practice the distributed conferencing and editing system of Jakobs with at least one personal computer, designated the host computer for given file editing operations, and having multi-tasking processing means for coordinating the execution of said file editing, and for coordinating the transfer of data corresponding with, and limited to, the file editing operations from the host computer to the display means of the others of the plurality of personal computers whereby the file editing operations and corresponding limited data transfer are performed in a predetermined manner by the host computer because of the benefits gained by the system of Jakobs in being able to take advantage of using common and well-known local area networking methods as was implicitly suggested by Jakobs. Further, Jakobs suggested the arrangement where one workstation was controlled by another workstation (col.16, lines 21-23).

Jakobs did not explicitly teach that editing comprised edits of less than the entire file, but since Jakobs did teach that "changes made to the image made at one workstation [are] instantly viewed by the users at all workstations" (col.6, lines 61-62), Jakobs implicitly taught that the editing comprised edits of less than an entire file because if editing were done to an entire file before transfer to the other users, it would not be possible for the other users to instantly view the changes.

Claim 9 is essentially the same as claim 1 except for the additional limitation, which was taught by Jakobs (col.9, lines 7-15), that the designated host computer is

Art Unit: 2307

interconnected with an input means. Claim 9 would have been obvious for the same reasons as set forth for claim 1 and is, therefore, rejected for the same reasons as set forth for claim 1.

Claim 23 is essentially the same as claim 1 except for the additional limitation, which was taught by Jakobs (col.6, line 66-col.7, line 6), that all users are in voice communication during a given editing operation. Claim 23 would have been obvious for the same reasons as set forth for claim 1 and is, therefore, rejected for the same reasons as set forth for claim 1.

Claim 11 is essentially the same as claim 9 except for the additional limitation (as asserted by Appellant in the discussion of claim 11 at p.31 of Appellant's brief) that requires that the users be in voice communication.

Jakobs did not teach that the users were required to be in voice communication, but neither does claim 11. Claim 11 merely specifies, and Jakobs taught (col.8, line 54-col.9, line 6), that the voice communications means is for transmitting audio signals representative of any user's voice to each other user. Therefore, claim 11 would have been obvious for the same reasons as set forth for claim 9 and is, therefore, rejected for the same reasons as set forth for claim 9.

(11) *Response to argument.*

Appellant's arguments are persuasive, but are deemed to be moot in light of the new grounds for rejection.

Serial Number: 07/975,905

-8-

Art Unit: 2307

(12) *Period of response to new ground of rejection.*

In view of the new ground of rejection, appellant is given a period of TWO MONTHS from the mailing date of this examiner's answer within which to file a reply to any new ground of rejection. Such reply may include any amendment or material appropriate to the new ground of rejection. Prosecution otherwise remains closed. Failure to respond to the new ground of rejection will result in dismissal of the appeal of the claims so rejected.

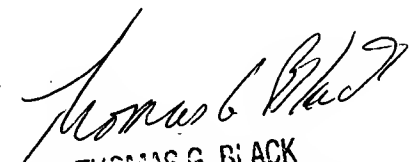
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Peter Y. Wang
Patent Examiner
Art Unit 2307

PYW
April 26, 1995



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